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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,613	03/12/2001	Richard M. Ozanich	P-1259-011	3155

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EXAMINER

EVANS, FANNIE L

ART UNIT	PAPER NUMBER
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2877

DATE MAILED: 03/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/804,613

Applicant(s)

OZANICH, RICHARD M.

Examiner

F. L. Evans

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23 is/are allowed.
- 6) ☒ Claim(s) 1-8, 16-19 and 63 is/are rejected.
- 7) ☒ Claim(s) 9-15, 20-22, 24-62 and 64 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

The Substitute Specification

Receipt is acknowledged of the substitute specification filed on October 3, 2003.

The last sentence under the heading "Continuation In Part Application" on page 12 should be deleted because reference to page 56 would have no meaning in a resulting patent.

Lines 7 and 8 should be cancelled from page 7. An information disclosure statement is not in the file wrapper of this application. With respect to applicant's comments in the paragraph bridging pages 3 and 4 of the amendment filed in October 3, 2003, the examiner has considered the prior art cited in the information disclosure statement filed in application Serial No. 09/524,349. However, if applicant wants the information to be printed on a resulting patent the information disclosure statement must be resubmitted. See the text in section I.A.2. - "IDS IN CONTINUED EXAMINATIONS OR CONTINUING APPLICATIONS" in MPEP § 609.

The underlining and bold type on pages 1, 2, 7, 11, 19, 54, 55, 56 and 60-63 must be deleted. See 37 CFR § 1.77(c). Such underlining would cause confusion in a reissue application, if filed in the future.

Claim Objections

All of the claims contain a period after the alphas at the beginning of the subsections of the claims. Each claim begins with a capital letter and ends with a period. Periods may not be used elsewhere in the claims except for abbreviations. Cancellation of the periods is required.

Claims 9 and 25 are objected to because they include reference characters which are not enclosed within parentheses. See reference character 182 in line 26 of claim 9 and reference character 3 in lines 4 and 6 of claim 25.

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

With respect to claim 54, “common to the industry” (bridging lines 3 and 4) and common to other industries” (in line 6) should be deleted.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-19 and 63 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 contradicts claim 9. Claim 9 specifies that the at least one detector is a light pickup fiber. See line 7 of claim 9. Dependent claim 16 specifies that the at least one light detector is comprised of a plurality of light detectors. Dependent claim 18 inherits the problem of claim 16.

Lines 2 and 3 of claim 17 are confusing and not understood. Correction or clarification is required.

The nature of the at least one light source is confusing as set forth in lines 2-5 of claim 19. Is the at least one light source comprised of an ellipsoidal reflector having a 50 w bulb with a cooling fan or is the at least one light source a plurality of illumination fiber? Correction or clarification is required.

With respect to line 4 of claim 19, it appears that "one" should be --two--.

Regarding claim 63, the use of "e.g." renders the claim indefinite because it is unclear whether the limitation following "e.g." is part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 8 is rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Ullrich et al (US 3,152,587), newly cited.

Ullrich et al an apparatus for determining characteristics of a sample comprising at least one light source (7a); a sample (ear lobe or finger tip) having a surface and interior; input mechanism (1) for positioning the at least one light source proximal the sample surface; at least one light detector (8); an output mechanism (2) for positioning the at least one detector proximal the sample surface; and at least one mechanism (20) for measuring the illumination detected from the sample. Applicant's attention is directed to Ullrich et al in its entirety with particular attention directed to Figs. 1, 3 and 4; lines 15-38 in column 1; the paragraph bridging columns 2 and 3; and all of column 3.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, respectively, of U.S. Patent No. 6,512,577 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application.

Allowable Subject Matter

Claim 23 is allowed over the prior art of record.

Claims 9-15, 20-22, 24-62 and 64 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and correcting any objection set forth above.

Claims 16-19 and 63 would be allowable if rewritten in independent form to overcome the rejection(s) under 35 U.S.C. § 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claim 8 have been considered but are moot in view of the new ground(s) of rejection. Applicant's attention is directed to the fact that claim 8 filed on November 21, 2003 does not specify a broadband light source.

With respect to applicant's remarks under the heading "Double Patenting Rejection" on page 2 of the amendment filed on October 3, 2003, a terminal disclaimer is not present in the file of this application.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Fax/Telephone Numbers

Papers related to this application may be submitted to Technology Center 2800 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The fax number for Technology Center 2800 is (703) 872-9306 for regular and After Final communications.

If applicant wishes to send a fax containing a Proposed Amendment for discussion during either a personal interview or a telephone interview then the fax should:

- 1) Contain either the statement "**DRAFT**" or "**PROPOSED AMENDMENT**" on the Fax Cover Sheet; and
- 2) Should be unsigned by the attorney or agent.


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This will ensure that the amendment will not be entered into the application and will be forwarded to the examiner as quickly as possible.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner whose telephone number is (571) 272-2414. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank G. Font, can be reached on (571) 272-2415. The TC Receptionist's telephone number is (571) 272-1562.

Any other inquiry of a technical nature, and all inquiries of a general nature including those relating to the status of an application should be directed to TC 2800 Customer Service Office whose telephone number is (571) 272-1585.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


F. L. EVANS
PRIMARY EXAMINER
ART UNIT 2877

file

March 7, 2004